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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,722	11/28/2000	John P. Anderson	00228-US-NEW2C1	9856

20350 7590 11/05/2004

TOWNSEND AND TOWNSEND AND CREW, LLP  
TWO EMBARCADERO CENTER  
EIGHTH FLOOR  
SAN FRANCISCO, CA 94111-3834

EXAMINER

WALICKA, MALGORZATA A

ART UNIT PAPER NUMBER

1652

DATE MAILED: 11/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/723,722

Applicant(s)

ANDERSON ET AL.

Examiner

Malgorzata A. Walicka

Art Unit

1652

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 August 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 19 August 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_.

3. ☒ Applicant's reply has overcome the following rejection(s): see the attached.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see the attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1-4, 15, 18, 22-25, 29-36, 132 and 133.

Claim(s) withdrawn from consideration: 5-13, 19, 27-28, 37, 39-53.

8. ☒ The drawing correction filed on 10 November 2003 is a) ☒ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

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The Amendments filed August 19, 2004 is acknowledged. Claim 21 is cancelled. Claims 1, 15, 24, 25, 12 and 133 are amended. Claims 1-13, 15, 18-19, 22-25, 27-37, and 39-53 and 132-133 are pending in the application. Claims 1-4, 15, 18, 22-25, 29-36 and 132-133 are the subject of this Office Action; claims 5-13, 19, 27-28, 37 and 39-53 stand withdrawn from further consideration.

## **2. Objections**

### **2.1. Specification**

Objection to the specification has been withdrawn, because the second amended sequence listing has been filed.

### **2.2. Claims**

Objection to claims 15, 23, 24, 25 for the improper quotation of the amino acid residues, is withdrawn because the claims have been amended.

Objection to claim 25 as containing the typographical error "SEQ ID NO: 43 [46-452]" is withdrawn, because the claim has been amended.

## **3. Rejections**

### **3.1. 35 USC, section 112, second paragraph**

Rejection of claims 2, 132 and 133 is withdrawn, because the claims have been amended.

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### **3.2. 35 USC section 112, first paragraph**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

#### *3.2.1. Lack of written description*

Claim 1 and dependent claims 2-4, 22, 23, 24, 29-36, and 132-133 remain rejected under 35 U.S.C. 112 for lack of written description of function, for reasons stated in the final Office Action and earlier Office Actions.

#### *3.2.2. Scope of enablement*

Claim 1-4, 22, 23, 24, 26-36, and 132-133 remain rejected under 35 U.S.C. 112, first paragraph, for reasons stated in the final Office Action.

In their response Applicants argue, “the specification further describes a assay for determining whether a segment of beta-secretase is active [thus enabling the claims]”, page 27 of 30, line 3. Applicants’ argument has been fully considered but is found not persuasive. Although the specification enables determining whether a segment of beta- secretase is active, the claims are not limited to active segments of

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SEQ ID NO: 2 or to a protein comprising such segments and having the function of beta- secretase.

### **3.3. 35 USC, section 102**

Rejection of claims 1 and 22 under 35 U.S.C. 102(e) as being anticipated by US patent No. 6,319,689 is withdrawn, because clam 1 has been amended.

### **3.4. 35 USC section 103**

Rejection of claims 23 and 29-30 is withdrawn because claim 1 from which rejected claims depend has been amended.

### **3. 5. Double patenting rejection**

All provisional obviousness-type double patenting rejections of claims 1-4, 15, 18, 22-25, 29-34 and 36 over the claims of US patent application No. 09/724,569 ('569) is maintained because Applicants did not filed the terminal disclaimer. The non-provisional obviousness-type double patenting rejections of claims 1 and 2 over claims 1, 2, and 6 ofr US Patent No. 5,744,346, made in the final Office Action, and earlier, are maintained, because Applicants did not filed the terminal disclaimer.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka, Ph.D., whose telephone number

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is (571) 272-0944 and the right fax number is (571) 273-0944. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 4:30 p.m. EST.

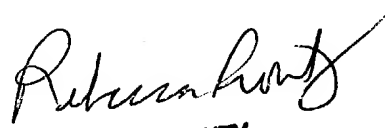
If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, Ph.D. can be reached on (571) 272-0928. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionists whose telephone number is (703) 308-0196.

Malgorzata A. Walicka, Ph.D.

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Patent Examiner

  
REBECCA E. PROUTY  
PRIMARY EXAMINER  
GROUP 1800-  
1620